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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masahide MIURA

Group Art Unit: 1793

Application No.: 10/589,669

Examiner: A. ZIMMER

Filed: August 16, 2006

Docket No.: 129110

For: METAL OXIDE PARTICLE, PRODUCTION PROCESS THEREOF AND EXHAUST
GAS PURIFYING CATALYST

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the August 12, 2008 Restriction Requirement, Applicant provisionally elects Group II, claims 6-8 drawn to an exhaust gas purifying catalyst, and Species "ceria" as the second metal oxide, with traverse. In response to the Election of Species Requirement, Applicants respectfully assert that at least claims 1, 2, 6, 7, and 9 are generic to the elected species. Furthermore, Applicants respectfully assert that at least claims 1-3, 6, 7, and 9 read on the elected species.

Applicants respectfully submit that there exists *a priori* unity of invention with respect to claims 1-9, by virtue of the fact that claims 6-8 variously depend from claims 1-5. As stated in Chapter 10.06 of the ISPE (*International Search and Preliminary Examination Guidelines*):

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and

contains a reference, preferably at the beginning, to the other claims and claims and then states the additional features claimed (Rule 6.4).

Therefore, each dependent claim shares at least each element or technical feature of independent claim 1. ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claims are known. See ISPE 10.07 and 10.08.

The Office Action does not establish that each and every element of independent claim 1 is known in the prior art. Therefore, Applicant respectfully submits that lack of unity of invention has not been established, and thus a Restriction Requirement at this time is improper.

Regarding the Election of Species Requirement, it is strongly traversed since it is contrary to PCT rules. For example, Article 27 of the Patent Corporation Treaty requires that: "no national law shall require compliance with requirements relating to the form or contents of the international application different from or in addition to those which are provided for in this Treaty and the regulations."

Further, PCT Rule 13 requires that claims which encompass one single general inventive concept be searched and examined in the same international application. For example, PCT Rule 13.1 states: "the international application shall relate to one invention or to a group of inventions so linked as to form a single general inventive concept."

Furthermore, PCT Rule 13.4 expressly states that: "subject to Rule 13.1, it shall be permitted to include in the same international application a reasonable number of dependent

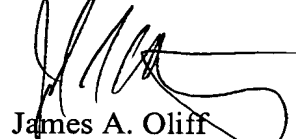
claims claiming specific forms of the invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention."

The Election of Species Requirement is a convention specific to U.S. National Patent Application Examination practice. PCT Rule 13.1 specifically contemplates the single examination of a group of inventions so linked as to form a single general inventive concept, and PCT Rule 13.4 specifically requires examination of species claims within a single general inventive concept. Nothing in the PCT or its rules permits issuing an Election of Species Requirement. Any United States practice (such an Election of Species Requirement) or interpretation of the rule which is different from or in addition to the unity of practice as delineated in PCT Unity Rules 13.1-13.4 is necessarily in violation of PCT Article 27. Species practice is not provided for under PCT Rules 13.1-13.4 and is contrary to PCT Article 27, and the present Election of Species Requirement is accordingly prohibited by Article 27.

Applicants further understand, however, that upon search, examination and allowance of the elected species, search and examination will continue as to the non-elected species within the scope of the generic claims.

Thus, withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Joel S. Armstrong
Registration No. 36,430

JAO:JSA/sxl

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OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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